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EXAMINER	
WANG, JUE S	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/787,196	ONO, KENICHIRO	
	Examiner	Art Unit	
	JUE S. WANG	2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 February 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *36-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *36-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/379,731.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 36-41 have been examined.

2. Claims 1-35 were cancelled in Preliminary Amendment dated February 27, 2004.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 36, 38, and 40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, and 3 of U.S. Patent No. 6,728,956 B1.

5. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the present application and U.S. Patent No. 6,728,956 B1 describe an information processing apparatus with receiving means, display control means, updating means.

For example, claim 36 of the present application discloses an information processing apparatus with updating means that is an obvious variation of the information processing apparatus recited in claim 2 of U.S. Patent No. 6,728,956 B1. While claim 2 of U.S. Patent No. 6,728,956 B1 does not specifically recite that the receiving means receives broadcast waves and the display control means displays an image in accordance with the received broadcast waves, it would have been obvious to one of ordinary skill in the art that the information processing apparatus would have been capable of receiving broadcast waves since the information processing apparatus would have easily been upgraded with an expansion card such as a tuner card to receive and display broadcast waves. Furthermore, while claim 2 of U.S. Patent No. 6,728,956 B1 does not specifically recite inhibition means for inhibiting the display control means from displaying the image in accordance with the received broadcast waves when the update means is updating the program, it would have been obvious to one of ordinary skill in the art at the time of the invention that the display control means could have inhibited such display in an information processing apparatus capable of receiving broadcast waves since the display control means displays information denoting "updating" on the display screen during updating. Claim 1 further teaches that the apparatus is not operable during the update by reciting a reservation means for reserving a time when the information apparatus is operable and not updating the program during the reserved time. Therefore, while claim 2 does not explicitly exclude the display of non-update related information when displaying the updating message, it would have been obvious that non-updated information such as images associated with broadcast waves are not displayed during the update since the apparatus is not operable during the update.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 36-39 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Bacon et al. (US 5,440,632, hereinafter Bacon).

8. As per claim 36, Bacon teaches the invention as claimed, including an information processing apparatus operating on the basis of a program stored in program storage means (a reprogrammable subscriber terminal, see Figs 2A, 2B, abstract, lines 1-6, 20-23, column 2, lines 6-33), comprising:

receiving means for receiving broadcast waves and an update program which are transmitted from outside (see abstract, lines 14-20, column 2, lines 22-33, column 6, lines 15-20);

display control means for displaying an image in accordance with the received broadcast waves on a screen, on the basis of the stored program (see Fig 2A, item 127, column 6, line 15 – column 7, line 53, column 8, lines 30-45);

update means for updating the program stored in the program storage means with the update program received by said receiving means (see column 2, lines 22-33, column 14, line 65 – column 15, line 26); and

inhibition means for inhibiting said display control means from displaying the image in accordance with the received broadcast waves on the screen when said update means is updating

the program (see column 14, line 65 – column 15, line 26, column 16, lines 1-40; EN: there must be an inhibition means to inhibit displaying the received broadcast waves during update since programming will be unavailable during updating).

9. As per claim 37, Bacon teaches that the information processing apparatus further comprising version information storage for storing version information of the stored program (see Fig 6, column 13, lines 5-6, 33-36).

10. As per claim 38, Bacon teaches that the information processing apparatus further comprising condition control means for setting, on the basis of time information, said information processing apparatus to a condition in which said information processing apparatus is able to receive the update program (see column 10, lines 1-4, column 15, line 55 – column 16, line 42; EN: the immediate flag is the time information as it dictates when the update should occur),

wherein the time information is transmitted in advance of the transmission of the update program and is received by said receiving means (see column 2, lines 44-51, column 15, line 38 – column 16, line 42).

11. As per claim 39, Bacon teaches that the information processing apparatus further comprising comparison means for comparing the version of the stored program and a version of the updating program (see Fig 9, step A68, column 15, lines 45-51),

wherein when the version of the stored program differs from the version of the updating program, said update means updates the program stored in the program storage means with the update program (see Fig 9, steps A68, A70, column 15, lines 45-68).

12. As per claim 41, Bacon teaches that the information processing apparatus further comprising:

selection means for selecting the broadcast waves received from outside (see column 7, line 53 – column 8, lines 11); and;

setting means for setting a condition in which said selection means cannot perform selection of broadcast waves during the program updating (see column 14, line 65 – column 15, line 26, column 16, lines 1-40; EN: there must be a setting means since interactive sessions with the subscriber will be interrupted during updating),

wherein said display control means displays the image in accordance with the broadcast waves selected by said selection means (see Fig 2A, item 127, column 6, line 15 – column 8, line 11).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bacon et al. (US 5,440,632, hereinafter Bacon), in view of Fletcher et al. (US 6,009,274, hereinafter Fletcher).

15. As per claim 40, Bacon does not teach that the information processing apparatus further comprising reservation means for reserving a reservation time when said information processing apparatus is operated, wherein said update means does not update the program when the reservation time and the time indicated by the time information overlap.

Fletcher teaches a method of updating software components on an end system on the network (see abstract), including reservation means for reserving a reservation time when the end systems are operated, wherein the end systems are not updated during the reservation time (i.e., time period excluded for updating, see column 12, lines 45-49, column 18, lines 42-45).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the apparatus of Bacon to include a reservation means for reserving a reservation time when the information processing apparatus is operated and update means does not update the program during the reservation time as taught by Fletcher because there are periods of time when the subscriber might not want to be interrupted by the updating process such as when recording a premium event that he has paid for (see column 16, lines 1-8 of Bacon). Furthermore, while neither Bacon nor Fletcher teaches that the updating means do not update when reservation time and the time indicated by the time information overlap, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bacon such that the update does not occur when the reservation time and the time indicated by the time information overlap (i.e., when the time indicated by the time information specifies that the

update occurs immediately) because doing so would disrupt the premium event that is being recorded during the reservation period.

Response to Arguments

16. Rejection of claims 24-47 under §103(a):

17. As per independent claim 36, Applicant argued that Bacon does not teach or suggest in any way that the unavailability of display of the content during downloading of new control software is the result of action by microprocessor 128, or any other element in the Bacon apparatus, inhibiting the display. Applicant also pointed out that claim 36 does not merely recite that display of the image becomes impossible, but recites an actual element, the inhibition means, that performs inhibition. Applicant's arguments have been fully considered and Examiner respectfully disagrees. Examiner interprets the inhibition means that performs the inhibition recited in claim 36 as part of the program stored in program storage means and therefore, the inhibition means is interpreted as program instructions. Nothing in the claim language recite that the inhibition means is an actual physical element such as a microprocessor and Examiner is unable to find any physical structure performing inhibition means in the specification. Bacon teaches that programming will be unavailable during the software update (see column 16, lines 1-42, specifically "a message will be displayed to the subscriber indicating that "New software is available" and requesting "is it OK to update the software (this will take about minutes during which programming will not be available)?"). When the user indicates that it is alright to download software, the terminal resets and this will cause the downloading program of the boot

program to activate and download the particular program code (see column 16, lines 36-42). The download program erases the FLASH memory as part of the download process, and downloads the program, initializes the hardware and start the new control program (see column 14, line 65 - column 15, line 26). It is further evident that the display is inhibited during this download process since the control program is unavailable and the control program is used to control all operations of the terminal for displaying programming (see column 6, lines 15-20, column 7, lines 40-51, column 8, lines 30-49). Therefore, the download program is the inhibition means that performs inhibition and Bacon teaches claim 1 as recited.

18. Double Patenting Rejection:

19. Applicant traverses the obvious type double patenting rejection because the use of split-screen and windowing techniques is well known, and these techniques would permit both information denoting "updating" and non-update related information to be displayed. Examiner submits that while such techniques exists for displaying both update and non-update related information simultaneously, it would still be obvious that without such techniques (which are not recited in the claims), the update and non-update related information would not be displayed simultaneously and the update information would inhibit the display of non-update related information. Furthermore, claim 1 of US 6,728,956 recites "reservation means for reserving a time when said information processing apparatus is operated, wherein said updating means does not update the program when the reserved time and time indicated by the time information overlap". It would have been obvious to one of ordinary skill in the art that images in accordance

with the received broadcast waves is not displayed on the screen since the apparatus is not operable during the update. Therefore, the obvious type double patenting rejection of claims 36, 38, and 40 are maintained.

Conclusion

20. **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jue S. Wang whose telephone number is (571) 270-1655. The examiner can normally be reached on M-Th 7:30 am - 5:00pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lewis Bullock can be reached on 571-272-3759. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lewis A. Bullock, Jr./
Supervisory Patent Examiner, Art Unit 2193

Jue Wang
Examiner
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